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To: **Mail Stop Appeal Brief- Patents**
Examiner Krisanne Marie Jastrzab, GAU: 1744
Fax No.: (571) 273-8300
From: George M. Macdonald
Date: February 6, 2006
Subject: Serial No.: 10/036,991
Pages: 11 (including this cover)

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FEB 06 2006

Re: U.S. Patent Application Serial No.: 10/036,991
Confirmation No.: 5304
Our Docket # F-424

Enclosed please find Appellant's Reply Brief on Appeal in furtherance of the June 30, 2005 Notice of Appeal.

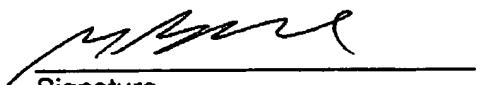
CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that the following correspondence is being transmitted via facsimile to:

U.S. Patent and Trademark Office
Attention: Examiner Krisanne Marie Jastrzab, GAU: 1744
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1. Appellant's Reply Brief on Appeal (3 pages)
2. Board Remand in U. S. Patent Application Serial No. 10/036,982 (7 pages).

on February 6, 2006
Date of Transmission


Signature

George M. Macdonald
Name of Registered Rep.
Reg. No.: 39,284

February 6, 2006
Date

Serial No.: 10/036,991
 Attorney Docket No.: F-424

Patent

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
 BOARD OF PATENT APPEALS AND INTERFERENCES**

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FEB 06 2006

In re patent application of:) Attorney Docket No.: F-424
 William E. Ryan, Jr., et al.) Customer No.: 00919
 Serial No.: 10/036,991)
 Filed: December 31, 2001) Examiner: Krisanne Marie Jastrzab
 Confirmation # 5304) Group Art Unit: 1744
) Date: February 6, 2004

Title: **SYSTEM FOR SANITIZING INCOMING MAIL**

Mail Stop Appeal Brief- Patents
 Commissioner for Patents
 Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF ON APPEAL

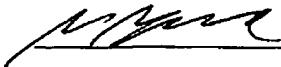
Sir:

The Appellants respectfully submit this reply brief pursuant to 37 C.F.R. § 41.41 in reply to the Examiner's Answer filed on December 6, 2005 in the appeal of the subject application. The Notice of Appeal was filed on June 30, 2005, and the Appellant's Brief was filed on August 30, 2005. The Commissioner is hereby authorized to charge any additional fees that may be required for this appeal or to make this brief timely or credit any overpayment to Deposit Account No. 16-1885.

In section II of the August 30, 2005 opening brief, Appellants note the remand in United States Patent Application Serial No. 10/036,982 ('982 Application) entitled System for Detecting the Presence of Harmful Materials in an Incoming Mail Stream has been identified by Appellants as a Related Application in the Cross Reference to Related Application. While not styled a decision, Appellants are providing a copy of the remand herewith for clarity.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, on February 6, 2006 (Date of Transmission).
 George M. Macdonald, Reg. No. 39,284 (Name of Registered Rep.)



(Signature)

February 6, 2006 (Date)

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Attorney Docket No.: F-424

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Section 9, Grounds of Rejection

Appellants respectfully urge reversal for the reasons stated in the opening brief.

Furthermore, regarding the 102(e) rejection as discussed below, Appellants disagree that Call '664 is available as art. Furthermore, regarding claim 1, Appellants respectfully submit that Call '664 is not available to teach a filtered transition area between the sanitizer and output bin as claimed.

Furthermore, regarding the 103(a) rejection Appellants respectfully submit that the claimed structure is not taught in the cited references. With regard to claim 13, there is no teaching in the cited reference of a sanitizer module adjacent to a filtered transition area. With regard to claim 15 and as discussed more fully below, Call '664 is not available to teach an output module outside of the chamber as clearly claimed here:

a clean area, the clean area for containing the output module, the clean area connected to the sanitization area at a sanitization zone, the sanitization area having an area pressure lesser than an air pressure in the clean area.

Section 10, Response to Argument

As noted by the Examiner, Appellants disagree that Call '664 is available as a reference unless supported by the underlying provisional. Additionally, Appellants submit that any subject matter in the provisional that is not published with the published application is also not available as prior art. Appellants noted in the opening brief that the Examiner cited to Fig. 1 and items numbered 900 that did not appear to be in the provisional. The Examiner states in the Answer: "this is not correct. Within the body of the rejection, the Examiner clearly points to column 2, paragraph 0020, column 7, paragraphs 0100, 0108 and 0109, column 8 and column 9, paragraph 0118 of Call '664." However, Appellants note that in Column 7, paragraph 108 and all of column 8 of Call '664 does indeed contain reference to Fig. 1 and many reference numerals in the 900 range. Appellants are not attempting to unduly cloud issues, but note that Fig. 1 of Call '664 differs significantly from Figs. 1-2 of the provisional including at which point in

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the line of equipment that filtration is placed. As taught in the present application, it can be advantageous to select certain portions of mail processing equipment for placement in the sanitizer room with others selected for placement in the post sanitizer clean room. For example, in the provisional, the outgoing mail handler is inside the containment chamber and in Call '664, Figure 1 does not include an outgoing mail handler. Appellant has searched Call '664 and finds the only reference to "output mail handler" in paragraph 127 that was not cited, but its location outside of the containment chamber as described in Fig. 1 of Call '664 is not supported in Fig. 1 of the underlying provisional.

The Examiner points to page 11, lines 5-28 and page 13 of the provisional and states that they "directly correspond" to the cited passages of Call '664. Appellants are not sure if that statement was intended to convey that their language is identical. The language in Call '664 is not identical. Of course, in some cases, a provisional using different language could support the subject matter of a particular printed publication. Here, the location of the outgoing mail handler has changed. Furthermore, the description of the incoming mail handler changes from arranging mail to separating mail.

Even if Call '664 was a proper reference, there is no motivation to combine it with Sterling '424 as there is no need in Call '664 for a decontamination gap. Furthermore, even Sterling '424 does not provide the structure missing from Call '664 as claimed.

In Conclusion, Appellants respectfully submit that the final rejection of claims 1-15 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,



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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

MAILED

JUN 10 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM E. RYAN, JR., ROBERT K. GOTTLIEB and JOSEPH D. MALLOZZI

Appeal No. 2005-0729
Application No. 10/036,982

Before FRANKFORT, MCQUADE and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

REMAND TO THE EXAMINER

This application is remanded to the examiner, pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)), for appropriate action with regard to the following issues.

(1) The effective filing date of the published Call application

In the final rejection (mailed November 6, 2003), the examiner rejected claims 1-11 under 35 U.S.C. § 103 as being unpatentable over Lopez et al. (hereinafter Lopez)¹

¹ U.S. Patent Application Publication No. 2003/0058099, published March 27, 2003, of Application No. 10/134,941, filed April 30, 2002, which is a continuation of Application No. 09/999,462, filed October 31, 2001.

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in view of Call et al. (hereinafter Call)² and, in the alternative, as being unpatentable over Lopez in view of Call, and further in view of Lohmann³ and/or Hayduchok et al. (hereinafter Hayduchok)⁴. Our review of the present application file indicates that the examiner did not cite the Provisional Application No. 60/337,674, on which the published Call application is purportedly based, and on the filing date of which the examiner relies in applying Call as prior art against the claims of the present application (answer, page 6), on a PTO-892 form or supply a copy thereof to the appellants. Moreover, the examiner failed to offer any explanation as to why the disclosure in the published Call application relied upon by the examiner was entitled to the benefit of the filing date of the provisional application.

The appellants argued on page 5 of their brief (filed May 5, 2004) that, in failing to provide a copy of Provisional Application No. 60/337,674 to support entitlement to the earlier filing date for the material in Call cited in the rejection, the examiner had failed to establish that Call is available as prior art against the appellants' claims. In response to that argument, the examiner simply stated, on page 6 of the answer (mailed August 30, 2004), that "Call is entitled to the benefit of the filing date of prior copending U.S. provisional patent application 60/337,674, filed on Nov. 13, 2001, and

² U.S. Patent Application Publication No. 2002/0124664, published September 12, 2002, of Application No. 10/066,404, filed February 1, 2002. This published application is based on prior U.S. Provisional Patent Application No. 60/337,674, filed November 13, 2001.

³ U.S. Pat. No. 6,169,936, issued January 2, 2001.

⁴ U.S. Pat. No. 6,303,889, issued October 16, 2001.

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therefore qualifies as a reference.⁵ The appellants again complained, on page 3 of their reply brief (filed September 3, 2004), that the examiner did not provide a copy of the provisional application to establish such entitlement and maintain their argument that "the current record does not support the use of Call '664 as a reference in the present case."

The examiner bears the initial burden of presenting a *prima facie* case of obviousness. See Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). It is thus the examiner's burden, in presenting a *prima facie* case of obviousness, to establish that Call is available as prior art under 35 U.S.C. § 102(e)⁶ with respect to the claims under appeal. This the examiner has not done.

At the very least, in order to establish that Call is available as prior art with respect to the claims under appeal, the examiner must provide the appellants with a copy of the provisional application on which it is based and point out where the disclosure relied upon in the rejection is supported in the earlier provisional application. We therefore remand this application to the examiner to review the disclosure of the provisional application to determine whether the disclosure in Call relied upon in the

⁵ The examiner's failure to provide the appellants with a copy of the provisional application at issue does not appear to have been in compliance with the USPTO policy then in effect, as set forth in the December 10, 2003 and October 29, 2004 memoranda issued to the Patent Examining Corps by Stephen G. Kunin, then Deputy Commissioner for Patent Examination Policy, directed to "transitional practice of supplying a copy of a provisional application relied upon to give prior art effect under 35 U.S.C. § 102(e) to a reference applied in a rejection."

⁶ 35 U.S.C. § 102(e) provides an exception, where the invention was described in an application for patent, published under section 122(b), by another filed in the United States before the invention thereof by the applicant for patent, to the general rule that a person is entitled to a patent.

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rejection is supported therein and, if the examiner determines that such disclosure is supported in the provisional application, (1) provide the appellants with a copy of the provisional application and (2) point out, on the record, where the material in Call relied upon in rejecting the claims under appeal is found in the provisional application.

(2) The appellants' disclosure of "a filtered transition area"

One of the argued distinctions between claim 1 under appeal and the applied prior art is the limitation "a filtered transition area downstream of the diverter." As such, it would not be prudent for us to decide this case without knowing what the appellants mean by this terminology. This filtered transition area is not illustrated in detail in any of the drawings of the present application. Rather, it is simply identified with the reference numeral 43 and an arrow in Figures 5a, 6, 7a, 8a and 9a. In Figures 5a, 6, 8a and 9a, the arrow indicates that the transition area 43 is located on the detection and/or sanitization area side of the dotted line partition between the detection and/or sanitization area and clean room while, in Figure 7a, the arrow points to the clean room side of the dotted line partition. On pages 12, 16 and 19 of the present specification, the appellants describe this transition area as follows:

Appropriate filtration and sealing can be provided in transition area 43 of the feed path F that is a passage between the clean room 42 and detection room 41 [sanitization area 40]. A containment module (not shown), for example, can be placed around that area with filtration devices and an opening along the feed path F to accommodate the largest mailpiece which can be sorted by the system.

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While this disclosure makes reference to "filtration" and "sealing," no filtration or sealing is illustrated in the drawings so as to permit us to understand what area of the disclosed system is filtered or sealed or where such filters or seals are located. Consequently, we have difficulty understanding what the appellants' disclosed "filtered transition area" is. We therefore remand this application to the examiner to consider whether the appellants' specification provides enabling disclosure of the "filtered transition area" in compliance with the first paragraph of 35 U.S.C. § 112 and to explain how this terminology in claim 1 is being interpreted.

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This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED

Charles E. Frankfort
CHARLES E. FRANKFORT

Administrative Patent Judge

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